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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,810	01/10/2001	Jochen Voss	Mo-6029/LeA 34,199	7359

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EXAMINER

BISSETT, MELANIE D

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/757,810

**Applicant(s)**

VOSS, JOCHEN

**Examiner**

Melanie D. Bissett

**Art Unit**

1711

-- The **MAILING DATE** of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

1. The rejection cited in the Office action dated 06 August 2002 has been altered; thus, the finality of the rejection has been withdrawn.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al. in view of Lane et al., as evidenced by Univar.

4. Wolf discloses a primer used for the metallization of a substrate. It teaches the substrates that may be used (col. 5 lines 1-3), which include inorganic glasses, metals, and plastics. Plastic substrates include ABS, polycarbonate, polyamides, polyesters, polyethylene, and polypropylene (col. 5 lines 1-13). One primer composition claimed involves a primer consisting of a film former of polyurethane (claim 2). Wolf discloses a primer comprising all of the elements in the applicant's claims 1 and 3, with the exception of a hydrophilic swelling agent (claim 1).

5. Lane shows a catalytic metal-polymer complex capable of facilitating the electroless metallization of a substrate, further teaching that an anticaking agent may be included in the composition (col. 5 lines 46-49). The laminate formed in the invention is deposited with a metal, rendering the inventive composition layer a base layer for metal (abstract). The compositions of Lane include a metal salt, synthetic monomers or polymers, a solvent, and a crosslinking agent (col. 3 line 66-col. 4 lines 31). Lane includes an anticaking agent like CABOSIL to facilitate the grinding of the metal salts

(col. 5 lines 44-55), where the metal salts include halides and acetates of palladium (col. 6 lines 4-32). Wolf intends the use of similar metal salt complexes in the invention (Wolf, col. 3 line 66-col. 4 line 22). It is the examiner's position that it would have been prima facie obvious to form the complex materials of Wolf's invention after grinding with a CABOSIL anticaking compound to facilitate the complexing reaction. An anticaking compound would preserve the large reactive surface areas of the ground metal salt particles by preventing the particles from agglomerating.

6. It is the examiner's position that the use of such a CABOSIL compound would anticipate the applicant's claimed hydrophilic swelling material, since the claimed properties are inherent to the material. Note that the applicant's specification points to CABOSIL materials as fitting the requirements for the swelling material, including specific surface area and diameter (p. 6 line 25-p. 7 line 13). CABOSIL is "an extremely finely divided silicon dioxide prepared by a special high-temperature hydrolysis process." Also, Univar confirms that untreated CABOSIL materials contain many surface silanol groups, which interact with other molecules (p. 9, col. 2). The surface area cited in Univar falls within the applicant's claimed range (p. 15, col. 2). The combination cited above would teach a primer composition comprising a CABOSIL material with the metal salt. Since CABOSIL materials are used in both the cited reference and the applicant's claimed invention, and because the materials are shown to have the applicant's claimed properties, it is the examiner's position that the material would inherently function as the claimed swelling material and would inherently possess the applicant's claimed spherical shape.

***Response to Arguments***

7. In response to the applicant's arguments that Lane does not mention the inclusion of silanol groups, the examiner has provided evidence to support the inherency argument that CABOSIL materials contain such silanol groups. Lane provides no indication for removing the anticaking agents from the metal salt mixture and does not indicate any detrimental effects of leaving the anticaking agent in the grinding mixture. Rather, the reference indicates that processing aids may be present in the composition (at least example 1). Thus, it is the examiner's position to interpret that the processing aids would be incorporated into the final product.

8. Regarding the arguments against the Volz reference, note that the Volz reference has not been relied upon by the examiner in the present Office action. Instead, it is the examiner's position that it would have been *prima facie* obvious to include an anticaking agent in the process for forming the metal salt complexes that are included in Wolf's invention.

9. In response to the applicant's arguments that Wolf disclaims the use of a swelling adhesion treatment, it is maintained that this does not exclude the use of a swelling agent in the primer composition. Rather, Wolf prefers not to swell the plastic *substrate* while adhering the primer and metallic layers. See Reichert et al., col. 1, defining swelling adhesion as a treatment of the substrate but not of the primer composition.

10. Regarding the applicant's arguments that the CABOSIL mentioned in Lane would not function or contribute to the properties of the composition, note that the discovery of

a new benefit from a known material is not patentable. Since the composition materials are the same, it is expected that the resulting product would have the same beneficial properties. Although Lane does not indicate property benefits from the addition of the CABOSIL, Lane recognizes that CABOSIL is useful as an anticaking agent for metal salts. This provides sufficient motivation for combining CABOSIL with a composition concerned with the metal salt reaction products. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

11. In response to the applicant's arguments that Lane discusses a laminate and not a primer, note that both Wolf et al. and Lane et al. are concerned with surfaces to be deposited with metal layers. Both compositions for the layer to be coated with metal include polymeric components and metal salt complex components. For these reasons, it is the examiner's position that the teachings of Lane et al. would be beneficial to one of ordinary skill in the art concerned with creating a primer for metal surfaces.


12. Regarding the applicant's arguments of unexpected results, it is the examiner's position that a trend of unexpectedly improved adhesion cannot be extracted from the applicant's examples. The applicant provides only one comparative example, which indicates that one specific primer composition has worse adhesion than other similar primer compositions. The examples are not commensurate in scope with the claims, at least since only one polymeric resin is included in all of the primer compositions, and only one type of metal is adhered to the primer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb

  
SAMUEL A. ACQUAH  
PRIMARY EXAMINER  
GROUP 120 / 700